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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/472,927	12/27/1999	SIVAKUMAR MUTHUSWAMY	CM013631	9383

7590

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EXAMINER

GRAVINI, STEPHEN MICHAEL

ART UNIT	PAPER NUMBER
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2162

DATE MAILED: 02/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

NA.

**Office Action Summary**

Application No.

09/472,927

Applicant(s)

MUTHUSWAMY ET AL.

Examiner

Stephen M Gravini

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. Specifically, the hypothetical address <http://www.website.com/sample-page> is considered an embedded hyperlink that may confuse the public upon publication of the application.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1 and 9 recite "recording interaction data relative to cursor placement on a specific defined space on the display area of a network site." The specification discusses script event handlers including an on mouse over feature that triggers an event when a user computer cursor moves over an object or an area from outside that object or area. This script event handler discussion does not describe the recited subject matter in such a way as to enable one skilled in the art of measuring network user interaction, to make and/or use the invention because mere assertion of

cursor placement does not record interaction data as claimed. Claims depending upon rejected claims 1 and 9 are also rejected since they depend upon a non-enabling claim. Examiner will treat the claims in light of the prior art under the assumption that claims 1-14 are enabling.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Merriman et al. (US 5,948,061). Merriman et al. discloses a system comprising:

at least one server in communication with the network, the server hosting one or more network sites where each network site includes a display area

having one or more defined spaces, each defined space having a predetermined area on the display area of the network site (please see column 2 lines 59-66); and

at least one user computer in communication with the network, the user computer including a browser that selectively interacts with network sites, the user computer further having a cursor manipulated by the user about the display area of an interacted network site, and the user computer selectively recording interaction data relative to cursor placement on a specific defined space on the display area of the interacted network site and transmitting the interaction data to the server hosting the defined space (column 3 lines 5-23). Merriman et al. also discloses an internet network, website network site (column 2 lines 15-20), JavaScript program execution (implicitly taught at column 1 lines 28-43 and column 2 lines 21-23), interaction conclusion transmission (column 2 lines 25-30), frequency and duration cursor interaction recording (column 2 lines 30-36), and web page advertisements (column 1 lines 7-11).

Claims 9-14 are rejected under 35 U.S.C. 102(3) as being anticipated by d'Eon et al. (US 6,006,197). d'Eon et al. discloses a method comprising:

interacting with a network site through a browser on a user computer (please see column 3 lines 2-5);

selectively recording interaction data on the user computer relative to a cursor placement on a specific defined space on the display area of the interacted network site; (column 4 lines 23-34); and

transmitting the interaction data to the server hosting the defined space (column 5 lines 7-61). d'Eon et al. also discloses an internet network and browser interaction (column 1 lines 30-35), JavaScript program execution through cursor placement (implicitly taught at column 4 lines 54-56), interaction conclusion transmission (column 3 lines 37-46), and frequency and duration cursor interaction recording (column 3 lines 7-35).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US patents Dedrick (5,724,521) and Henrick et al. (6,055,510), foreign references Takahisa (WO 96/33561) and Healy et al. (WO 01/09789), and non-patent literature references Marketing: Ads Delivered, Online Advertising, IAB Study: Banner Ads, and Gardenswartz et al. (2002/0004754) teach on line advertising.

The best art in each category (U.S. Patents, Foreign publications, non-patent literature or NPL) is as follows:

- a. the closest U.S. Patent is d'Eon et al. (6,006,197) or Merriman et al. (5,948,061) discussed above rejecting the claims, giving a clear indication of why that reference was cited;
- b. the closest foreign publication reference is Healy et al. (WO 01/09789) because it teaches a method for tracking banner

- advertisements, which gives a clear indication of the related concept as claimed in the present application; and
- c. the closest NPL reference is Marketing: Ads Delivered in Real Time which discloses advertiser tracking of banner advertisements which gives a clear indication of the concept of applicants' invention as independently claimed.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Steve Gravini whose telephone number is (703) 308-7570 and electronic transmission / e-mail address is [steve.gravini@uspto.gov](mailto:steve.gravini@uspto.gov). Examiner can normally be contacted Monday through Friday from 6:00 a.m. to 3:30 p.m. **If applicants choose to send information by e-mail, please be aware that confidentiality of the electronically transmitted message cannot be assured.** Please see MPEP 502.02. Information may be sent to the Office by facsimile transmission. The Official Fax Numbers for TC-2100 are:

After-final	(703) 746-7238
Official	(703) 746-7239
Non-Official/Draft	(703) 746-7240

*Steve Gravini*  
**STEPHEN GRAVINI**  
**PRIMARY EXAMINER**

smg  
February 5, 2002